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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,155	08/08/2003	Patricia L. Redding	7315	2906

7590 08/18/2005

The Sherwin-Williams Company
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101 Prospect Avenue, N.W.
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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/637,155

Applicant(s)

REDDING, PATRICIA L.

Examiner

Margaret G. Moore

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 to 9, 14, 15 is/are allowed.
- 6) ☒ Claim(s) 10 to 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10 to 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over lida in view of Cremeans et al.

lida teaches an air drying coating composition containing a silicone modified acrylic grafted alkyd resin and a carboxyl group containing chlorinated polyolefin. See the teachings starting on the bottom of column 3 which detail the alkyd resin. This meets claimed component (a) as (a) is open to silicone modification. Starting on the bottom of 5 lida teaches the carboxyl group containing chlorinated polyolefin. See for instance that the polyolefin can be reacted with an unsaturated monomer having a carboxyl group (i.e. an acrylic acid). This falls within the breadth of claimed component (b). Pigments meeting (e) are taught on column 6, line 55 and on, while the last line on column 6 teaches a solvent (note that solvent will necessarily be volatile as it is used in an paint).

This differs from the instant claims only in that lida fails to teach a drying agent. The use of drying agents, in an effort to expedite alkyd resin drying, is well known in the art. See for instance Cremeans et al., column 6, line 17 and on, which notes that drying agents are used to promote air drying in conventional alkyd resins.

Thus one having ordinary skill in the art would have been motivated by that which is known in the art, as exemplified by Cremeans et al., to add a drying agent to the composition of lida in an effort to expedite the air drying of the alkyd resin therein. In this manner instant claim 10 is rendered obvious.

For claims 11 and 12, see the ratio of chlorinated polyolefin to silicone resins in Table 2, as they meet these claims. Also note that these compositions are water free.

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3. Claims 1 to 9, 14 and 15 are allowed. The prior art fails to teach or suggest such an aerosol paint product. Acrylic modified alkyd resins and acrylic chlorinated polyolefin resins are both known but the prior art fails to provide adequate motivation to combine such components, particularly in an aerosol paint product as claimed. While one could argue the obviousness of combining two known compositions to arrive at a third composition, the Examiner draws attention to the teachings on column 2, lines 9 and on, of Maruo et al. which state "since the compatibility of the chlorinated polyolefins with the acrylic resins and the alkyd resins is inherently poor, the gloss of the coated layer is lowered...". This does not refer to a blend of the two resins required in claim 1, but it does cast doubt on one's expectation for success if one were to blend the two resins required in claim 1. In view of the teaching in Maruo et al., one would have at best an obvious to try motivation to combine these known resins and such a motivation is not adequate for establishing obviousness. Combined with this, the Examiner notes that it is not simply a combination of resins that is claimed but a particular aerosol paint product, or a process using such a product. Thus, in totality, the claimed product and process are novel and unobvious over the prior art.

The Examiner also draws attention to Ser, in which a acrylic grafted chlorinated polyolefin is disclosed. Column 3, lines 50 to 54, teaches the addition of an alkyd or acrylate resin but the Examiner simply could find no motivation to add an acrylic modified alkyd resin to such a composition. In hindsight, it would appear that a teaching of an alkyd or acrylate resin would imply that an acrylic modified alkyd resin could be used, but such hindsight is impermissible. The Examiner was unable to find any teaching in the cosmetic or nail polish art of acrylate modified alkyd resin film formers. Note too that the only aerosol spray taught in Ser is for fixing hair, which would lead one away from the addition of a colorant.

4. The amendment filed 1/30/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the description of

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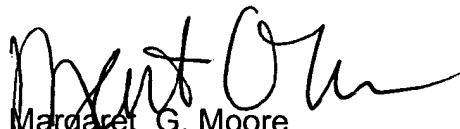
DORESCO® AC439-17. Applicants' comments indicate that this "merely expands the description and history of one of the useful resins" but there is nothing to support the correlation between DORESCO® AC439-17 and DORESCO® AC439-1. The product description provided by applicants does not remedy this discrepancy.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
8/15/05